

HONORABLE RONALD B. LEIGHTON

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT TACOMA

TERAGREN, LLC, a Washington limited
liability company,

Plaintiff,

v.

SMITH & FONG COMPANY, a California
corporation,

Defendant.

Case No. C07-5612RBL

ORDER DENYING IN PART AND
GRANTING IN PART TERAGREN'S
MOTION FOR RECONSIDERATION

This matter is before the court on Plaintiff Teragren's Motion for Reconsideration [Dkt. #60] of the Court's Markman Claims Construction ruling [Dkt. #59] Teragren asks the court to revise its construction of the term "random orientation" as used in United States Patent No. 5,543,197 (the "'197 patent"), and to clarify its ruling that the patent's claims do not apply to multilayered or laminated structures. For the reasons outlined below, and in the Markman Ruling, the Motion is Granted in part and Denied in part.

A. Standard for Reconsideration

Local Rule CR 7(h) provides in relevant part:

Motions for reconsideration are disfavored. The court will ordinarily deny such motions in the absence of a showing of manifest error in the prior ruling or a showing of new facts or legal authority which could not have been brought to its attention earlier with reasonable diligence.

Motions for Reconsideration are also disfavored, and should be denied in the absence of a showing

1 of manifest error in the prior ruling or a showing of new facts or legal authority that could not have been
2 brought to the court's attention earlier with reasonable diligence." *See Goldstein v. Continental Casualty Co.*,
3 509 F.3d 1042, 1051 (9th Cir. 2007).

4 Defendant¹ urges the Court to deny the Plaintiff's Motion under this standard, arguing both that
5 Plaintiff has failed to demonstrate manifest error and that it in fact invited the claims construction it now asks
6 the Court to revise.

7 The Court will address the merits of the Plaintiff's Motion notwithstanding the Defendant's technical
8 objections to it.

9 **B. The Court will not Reconsider its construction of the term "random orientation" of**
10 **the bamboo segments.**

11 Teragren asks the Court to Reconsider its ruling that the term "random orientation" in the '197
12 patent requires that the "bamboo segments have random, not uniform lengths, and are staggered or lapped
13 along the length of the beam." [Markman Claims Construction Ruling, Dkt. #59, at 9].

14 Specifically, the Court ruled:

15 The randomness feature of Plaehn's invention specifically included the
16 notion that the bamboo segments would be of random lengths, and placed
17 into the beam in a generally parallel fashion, but randomly with respect to
18 their vertical, horizontal, and rotational orientation, and furthermore that
19 they would be randomly staggered and lapped along the length of the beam.
20 For these reasons, the Court concludes that the term "random" or "randomly
oriented" as used in claims 1, 5, and 7 means that the bamboo segments and
stocks used to construct the bamboo beam are not placed in an orderly or
uniform fashion; they do not have a top or a bottom, or a front or a back.
Instead, they are placed at random. As used in the '197 patent, the term also
requires that the generally parallel bamboo segments have random, not
uniform, lengths, and are staggered or lapped along the length of the beam.

21 Plaintiff Teragren argues that the requirement of "random lengths" and "staggered or lapped"
22 placement along the length of the beam are both in error.

23 It focuses on the language of the claims themselves which describe segments having a random
24 vertical and horizontal orientation with respect to each other (see claim 5), and about the length and width
25 of each of said segments (see claim 1) and with respect to each other about the width and height of the
26 bamboo beam (see claim 7).

27
28 ¹Defendant Smith & Fong and Intervenor Anji Tianzhen jointly oppose Plaintiff Teragren's Motion
and will be referred to as "Defendant" in this Order.

1 Teragren argues that none of these claims requires that the bamboo segments have random (or not
2 uniform) lengths, or that they be staggered or lapped along the length of the beam. Indeed, they argue,
3 the lengths of the segments are specified in claim 5 – the segments are to be, in substantial number,
4 between 5 and 20 feet long, with shorter or longer segments permissible in small quantities.

5 Teragren argues that the ‘197 patent describes a beam that contains bamboo segments randomly
6 oriented vertically, horizontally, and rotationally, but that are not necessarily lapped or staggered, and are
7 not necessarily of random (or non-uniform) lengths. Teragren effectively argues that the beams described
8 in the patent could be like a box of uncooked spaghetti; the individual segments are randomly placed, but
9 are of uniform length and are not staggered.

10 Defendant argues that Teragren itself argued in its opening Brief [Dkt. # 41] (as Plaehn had
11 argued to the Examiner) that the staggered bamboo segments eliminated the inherent limitation in using
12 bamboo as a structural wood substitute. That inherent limitation – the distance between the annual rings
13 (weak points) in a given bamboo segment – was overcome in the Plaehn invention, because the staggering
14 allowed the manufacture of beams that were longer than that distance.

15 Teragren wrote:

16 In addition, the parallel stacking used in prior art beams limited the length of
17 bamboo beams. The beams could only be as long as the distance between the annular rings
18 in the bamboo stock. In contrast, the random stacking of the patented invention eliminated
19 this limitation because the staggering of the bamboo segments allowed the length of the
20 beam to exceed the length of the individual bamboo segments. This staggering also created
21 a stronger and more consistent product. As the inventor explained:

22 [T]he only mention in [the prior art] of a beam refers to using longitudinal layers
23 exclusively. The “longitudinal bamboo strips (1) are bamboo strips cut lengthwise
24 uniformly,” and [the prior art] recognizes the limitations created by the “presence
25 of annular rings in the bamboo trunk.” citation omitted] Therefore, the length of the
26 longitudinal strips, which are uniform in length, are limited by the distance between
27 the annular rings in the bamboo stock. (The presence of an annular ring in a
28 bamboo strip may present a weak point and discontinuity, greatly reducing the
strength and uniformity of the bamboo strip.) This limitation greatly limits the
possible lengths of the bamboo beams in [the prior art].

In the present invention, however, such limitations in
beams [sic] length are not present. The bamboo strips do not have
to be uniform lengthwise and may include the annular ring portions
of the bamboo segment. Furthermore, though the strips are parallel
in direction, they are random in horizontal and vertical orientation
and length. The advantage is that the randomness of this process
assures a uniform and length-wise staggered stacking of the
bamboo segments, allowing the length of the beams to exceed the
length of the bamboo segments themselves and negating any
weaknesses of the discontinuity of the annular rings. This

1 randomness not only ensures consistency in the physical
2 characteristics of the bamboo beams, it also provides a product
3 which is cheaper to manufacture because less work is required due
4 to the random parameters.

5 [Dkt. #41 at 4, 5].

6 Teragren acknowledges that it recited this claims history, but strenuously denies that it ever
7 asserted that the issued claims should be interpreted so as to require random lengths or staggering. [See
8 Dkt. #70 at 2]. Teragren's opening Brief did not attempt to distinguish or explain away this prosecution
9 history, though it also did not specifically reference it when articulating its own meanings for the claims'
10 terms.

11 In any event, it is clear that Plaehn, and then his counsel, consistently sought a patent by
12 emphasizing the primary benefit of his invention: the beams created could be longer than the distance
13 between the annual rings because the segments were staggered. He repeatedly emphasized this feature in
14 distinguishing the Chu patent. [See Seyedali Dec.,; Dkt. # 39, at: Ex. A, Original Application, p.4; Ex. D,
15 First Amendment, at p, 5; Ex. G January 1996 Amendment, at pp.7-8]. Each iteration of Plaehn's
16 submissions to the Examiner, and the '197 patent itself, touted the invention's object as providing "a
17 beam which can be manufactured to virtually any dimension." [See '197 Patent, Seyedali Dec., Ex. H at
18 3]. As Plaehn consistently argued, this feature was the direct result of the randomness (as opposed to
19 Chu's orderliness) of the bamboo strands, including their random lengths (generally within a range of 5 to
20 20 feet), and their random placement – or staggering – along the beam's length.

21 It is true that the issued '197 patent's claims do not specifically reference this feature. However, it
22 is also clear that the Examiner, who repeatedly rejected Plaehn's applications before ultimately accepting
23 his final Amendment, was not at any point concerned that the "randomness" described by Plaehn over
24 time was an impediment to the issuance of the patent. Instead, the Examiner (and Plaehn) focused on
25 whether or not his invention was sufficiently distinguished from the Chu patent's orderly stacking.

26 Based on this claim prosecution history, the Court concluded, and does conclude, that the meaning
27 of the term "random orientation" as used in the '197 patent, means bamboo segments which have random,
28 not uniform lengths, and which are staggered or lapped along the length of the beam.

The Plaintiff's Motion for Reconsideration on this point [Dkt.# 60] is therefore DENIED.

B. The Term “Bamboo Beam” Does not Include Layered or Laminated Products.

Teragren seeks Reconsideration, or clarification, of the statement in the Court’s Markman Ruling that the term “bamboo beam” as used in the ‘197 patent “does not include laminated or layered products.” [Dkt. 59 at 5]. The Chu patent, which Plaehn sought to distinguish, taught a laminated and/or layered bamboo board. Plaehn’s invention was not laminated or layered, and did not derive its structural strength from any skin or core. Put another way, the term “bamboo beam” as used in the ‘197 does not mean a beam which has layers or is laminated. Neither party disputes this ruling.

However, Teragren argues that adding a layer or lamination to an otherwise infringing product is not sufficient to avoid infringement [*See* Dkt. # 60 at 11,12], and apparently asks the court to so rule in this Order.

Defendant does not concede that adding a layer to an otherwise infringing product is necessarily insufficient to avoid infringement, [See Dkt. # 68 at 9, 10] and suggests that the addition of a new element may in some cases avoid infringement. Defendant appears to argue that the issue of infringement is beyond the scope of a Markman Claims Construction Ruling, and the Court agrees.

The Court's Markman Ruling was not intended to address whether an embodiment which adds a layer or lamination to an otherwise infringing product necessarily is or is not an infringement. Nothing in the Court's prior Ruling should be construed as a determination of that issue. If and to the extent this clarifies the Court's prior Ruling, the Motion for reconsideration on this issue is GRANTED.

IT IS SO ORDERED.

DATED this 5th day of May, 2009.

2009. Ronald B. Leighton
RONALD B. LEIGHTON
UNITED STATES DISTRICT JUDGE